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P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

ENGLAND, DAVID E

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT E. HAINES

Appeal 2007-2392
Application 09/976,715
Technology Center 2100

Decided: March 17, 2008

Before HOWARD B. BLANKENSHIP, JEAN R. HOMERE, and
MARC S. HOFF, *Administrative Patent Judges*.

BLANKENSHIP, *Administrative Patent Judge*.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134(a) from the Examiner's final rejection of claims 1-34, which are all the claims in the application. We have jurisdiction under 35 U.S.C. § 6(b).

We affirm, and enter a new ground of rejection in accordance with 37 C.F.R. § 41.50(b).

The invention relates to printers and other hard copy output engines, and to management of their consumable supplies. (Spec. 1.) A device discovery plug in is downloaded over a network, for collecting data describing peripheral devices related to a vendor associated with the device discovery plug in. (Spec. 2.) Claim 1 is illustrative.

1. A method of device discovery comprising:

downloading a device discovery plug in via a network using a network browser;

activating the device discovery plug in to discover peripheral devices on the network with the device discovery plug in; and

transmitting data describing peripheral devices discovered by the device discovery plug in.

The Examiner relies on the following references as evidence of unpatentability.

Sharpe Jr.	US 5,960,214	Sep. 28, 1999
Baker	US 6,405,204 B1	Jun. 11, 2002
Garland	US 6,674,764 B1	Jan. 6, 2004
Butt	US 6,754,829 B1	Jun. 22, 2004
Zintel	US 6,779,004 B1	Aug. 17, 2004
Pang	US 6,804,718 B1	Oct. 12, 2004

www.webopedia.com/TERM/n/network.htm. Last modified date: September 1, 1996.

Claims 1, 3, 4, 7, 8, 10, 11, 14, 15, 17, 20, 21, 23, 24, 27, 28, 30, and 31 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zintel and Butt.

Claims 2, 9, 18, and 22 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zintel, Butt, and Pang.

Claims 5, 6, 12, 13, 16, 19, 25, 26, and 32 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zintel, Butt, and Sharpe.

Claims 33 and 34 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Zintel, Butt, Sharpe, and Baker.

Claim 29 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Zintel, Butt, and Garland.

The standing rejections

I. Zintel

Zintel describes the Universal Plug and Play (UPnP) device control protocol. UPnP is an open network architecture designed to enable simple, ad hoc communication among distributed devices and services from many vendors. Zintel col. 4, ll. 44-65. UPnP uses a simple network device discovery protocol (SSDP) that operates in a multicast or server-based mode. Col. 10, ll. 20-42.

SSDP is a protocol that enables devices to learn of the existence of potential peer devices and the required information (an IP address) needed to establish connections with the devices. An SSDP search returns a Uniform Resource Locator (URL), which can be used to make a connection to the

discovered device. SSDP specifies, as previously noted, a default, automatic multicast operating mode, but also a server mode for registration and query. Zintel col. 12, ll. 47-64.

In Zintel's model, User Control Points have a user interface for accessing one or more Controlled Devices on the network. Zintel col. 13, ll. 56-60. Using the server mode for registration and query, a Discovery Client module in a User Control Point can initiate discovery of Controlled Devices. A Discovery Server on the Controlled Device responds to discovery requests. Col. 13, l. 65 - col. 14, l. 8; col. 11, ll. 5-20; col. 19, ll. 5-10; Figs. 1, 2 and 6 (Discovery Server on Device 202 returning Description URL).

Devices may be discovered on a local network, on a wide area network, or potentially anywhere on the Internet. Zintel col. 46, ll. 33-56. The discovery procedure provides an Extensible Markup Language (XML) format device description, which is downloaded to clients to allow activation of device functionality from the client. Col. 47, ll. 16-21; col. 48, ll. 17-41.

II. Butt

Butt describes downloading a plug-in via a network using a network browser. Col. 8, l. 59 - col. 9, l. 6.

III. Representative claims

We will consider the limitations of separate claims to the extent the claims are separately argued in the Appeal Brief. See 37 C.F.R. § 41.37(c)(1)(vii).

III.A. Claim 1

The Examiner rejects instant claim 1 as obvious over the combination of Zintel and Butt. The Examiner finds that Zintel teaches the claimed subject matter, but does not describe downloading a plug in via a network using a browser. According to the Examiner, it would have been obvious to use a browser to download a device discovery plug in, as taught by Butt, to obtain a device discovery module because it would enable a user to find the specific software that is needed. (Ans. 4-5.)

Appellant argues that “Zintel’s system has nothing to do with ‘discovering’ devices.” (App. Br. 11.) We disagree. See part I, above.

Appellant also argues that Zintel “teaches away” from downloading software from a network. (App. Br. 12.) We disagree. Zintel describes downloading software from a network (e.g., col. 51, ll. 29-31). Moreover, the reference teaches that a discovery module 954 (Fig. 26) may be associated with a browser on a network. Zintel col. 50, ll. 10-35.

We have considered all of Appellant’s arguments but are not persuaded of error in the rejection of claim 1. We sustain the rejection.

III.B. Claim 30

Claim 30 recites that the transmitting data describing the peripheral devices comprises transmitting the data to a vendor website. The claim does not specify what the vendor may be “vending.” We sustain the rejection over Zintel and Butts at least because, as previously noted, the device

discovery process described by Zintel may be implemented anywhere on a wide area network or over the Internet. Zintel col. 46, ll. 33-56.

III.C. Claim 5

Appellant argues that the combination of Zintel, Butt, and Sharpe does not teach activating a device discovery plug in or collecting data from an embedded web server contained in the discovered peripheral devices. (App. Br. 16-17.)

Claim 5, however, recites that the device discovery plug in is activated to collect data chosen from a group that includes “model and serial number information.” Zintel teaches (col. 8, ll. 54-65) that the information returned from a device may include a Device Friendly Name (human readable string) that contains manufacturer and model information, which at least suggests “model and serial number information.”

Moreover, the “model and serial number information” (and the “included options”), as claimed, represent nonfunctional descriptive material. The data is merely collected; the data does not functionally change the system that implements the method steps of base claim 1. The content of the nonfunctional descriptive material carries no weight in the analysis of patentability over the prior art. *Cf. In re Lowry*, 32 F.3d 1579, 1583 (Fed. Cir. 1994) (“Lowry does not claim merely the information content of a memory. . . . [N]or does he seek to patent the content of information resident in a database.”). *See also Ex parte Nehls* (BPAI Jan. 28, 2008), *available at*

<http://www.uspto.gov/web/offices/dcom/bpai/prec/fd071823.pdf>; *Ex parte Curry*, 84 USPQ2d 1272 (BPAI 2005) (nonprecedential) (Fed. Cir. Appeal No. 2006-1003, *aff'd* Rule 36 Jun. 12, 2006); *Manual of Patent Examining Procedure* § 2106.01 (8th ed., Rev. 6, Sept. 2007).

We sustain the rejection of claim 5.

III.D. Claim 29

Appellant submits that the combination of Zintel, Butt, and Garland does not teach or suggest activating a device discovery plug in to poll peripheral devices. (App. Br. 17-18.)

As previously discussed, Zintel describes the Simple Service Discovery Protocol (SSDP), which uses either a multicast mode or a type of polling in which a control device searches for devices on the network that can be controlled. Zintel col. 11, ll. 14 - 20; col. 12, ll. 56-64; col. 13, l. 65 - col. 14, l. 8. The information returned from a found device necessarily includes the network address of the device. Zintel col. 12, ll. 47-55.

We are thus not persuaded that the references fail to teach or suggest activating a device discovery plug in to poll peripheral devices. We sustain the rejection of claim 29.

III.E. Claims 33, 34

Appellant submits that the combination of Zintel, Butt, Sharpe, and Baker fails to teach or suggest identifying “a purchase authorizer” or “a maintainer” for “each group” as recited in claims 33 or 34. (App. Br. 18.)

Intervening claim 6, which depends from claim 1, recites “further comprising organizing collected data into suitable groups.” Claims 33 and 34 are drawn to, at best, manipulating a mere arrangement of data that does not functionally change the system that implements the method. The data is nonfunctional descriptive material, not entitled to weight in the patentability analysis. The actual requirements of claims 33 and 34 are taught at least by Zintel, which describes discriminating data elements from other data elements (e.g., col. 47, ll. 16-21).

We sustain the rejection of claims 33 and 34.

IV. Remainder of claims

We sustain the rejections applied against the remainder of the claims, being not persuaded of error in the rejection of any claim.

V. New ground of rejection

We reject claims 21-27 under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

The claims are drawn to a “computer instruction signal embodied in a carrier wave carrying instructions . . .” A carrier wave or signal is not statutory subject matter because it does not fall within any of the four categories of statutory subject matter. *See In re Nuijten*, 500 F.3d 1346, 1357 (Fed. Cir. 2007).

CONCLUSION

The rejection of claims 1-34 under 35 U.S.C. § 103(a) is affirmed.

A new rejection of claims 21-27 under 35 U.S.C. § 101 as being directed to non-statutory subject matter is set forth herein. With respect to the affirmed rejection(s), 37 C.F.R. § 41.52(a)(1) provides that “Appellant may file a single request for rehearing within two months of the date of the original decision of the Board.”

In addition to affirming the Examiner’s rejection(s) of one or more claims, this decision contains a new ground of rejection pursuant to 37 C.F.R. § 41.50(b). 37 C.F.R. § 41.50(b) provides that “[a] new ground of rejection pursuant to this paragraph shall not be considered final for judicial review.”

37 C.F.R. § 41.50(b) also provides that Appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of the appeal as to the rejected claims:

(1) *Reopen prosecution*. Submit an appropriate amendment of the claims so rejected or new evidence relating to the claims so rejected, or both, and have the matter reconsidered by the examiner, in which event the proceeding will be remanded to the examiner. . . .

(2) *Request rehearing*. Request that the proceeding be reheard under § 41.52 by the Board upon the same record. . . .

Should Appellant elect to prosecute further before the Examiner pursuant to 37 C.F.R. § 41.50(b)(1), in order to preserve the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the affirmed rejection, the effective date of the affirmation is deferred until conclusion of the prosecution before the Examiner unless, as a mere incident to the limited prosecution, the affirmed rejection is overcome.

If Appellant elects prosecution before the Examiner and this does not result in allowance of the application, abandonment or a second appeal, this case should be returned to the Board of Patent Appeals and Interferences for final action on the affirmed rejection, including any timely request for rehearing thereof.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a).

AFFIRMED -- 37 C.F.R § 41.50(b)

APJ Initials:

HBB
MSH
JRH

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Application 09/976,715

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HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins CO 80527-2400